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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,488	08/13/2001	Didier Candau	016800-457	5299

7590

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Norman H. Stepno, Esquire
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 04/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,488

Applicant(s)

CANDAU, DIDIER

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4,6-13 and 15-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

1. Applicant's election of species with traverse in Paper No. 7 is acknowledged. The traversal is on the ground(s) that it would not be an undue burden upon the Examiner to examine additional species. This is not found persuasive because formulas (I) and (III) of the instant invention encompass hundreds of compounds which require a burdensome search.
2. Claims 1-31 are pending in this application. Claims 1-4, 6-13 and 15-31 are readable on the elected species. Claims 5 and 14 are withdrawn from consideration as directed to non-elected species.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 6,251,373.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are directed to topically applicable sunscreen/cosmetic

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compositions for protecting human skin and/or hair against the damaging effects of UV radiation comprising at least one benzotriazole compounds and at least one bis-resorcinyltriazine compound in a cosmetically acceptable carrier. The difference between the instant claims and those of '373 is that the claims of '373 recite an additional sunscreensing compound, which is not excluded by the open-end language of the instant claims.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 4 and 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 4 and those dependent thereon are viewed as indefinite because they recite the limitation "m is 0 or 1". Claim 6 and those dependent thereon are viewed as indefinite because they recite the limitation "m = 0 or [m = 1 and X = O]. The recitations are confusing because there is no "m" in the formula (II).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1-4, 6-13 and 15-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Hansenne (US 6,030,629) or Allard et al. (US 6,171,579) in view of Huglin et al. (EP 0 775 698).

Hansenne teaches topically applicable sunscreen/cosmetic compositions for protecting human skin and/or hair against the damaging effects of UV radiation comprising at least one benzotriazole-substituted silicone compound of the instant invention in an amount of from 0.1 to 20%. See col. 5, lines 20-62; col. 6, lines 1-5. The benzotriazole-substituted silicone compound of Hansenne is used in combination with other sunscreen compounds such as triazine derivatives. See col. 7, line 16. The compositions of Hansenne may additionally contain other hydrophilic or lipophilic organic sunscreens, inorganic sunscreens such as titanium dioxide, iron oxide, zinc oxide, etc., artificial tanning agents, cosmetically acceptable adjuvants such as fats, organic solvents, thickeners, etc. and may be formulated as emulsions, creams, gels, lotions, solid sticks and the like. See col. 7, lines 9-49; col. 8, lines 24-31. The compositions of Hansenne can be used in make-up products and in hair care products. See col. 8, lines 32-49. The compositions of Hansenne are applied to human skin and/or hair and have SPF above 2. See col. 8, lines 62-67; col. 10, Table II.

Allard et al. teaches cosmetic compositions for UV-protection of skin and/or hair comprising 0.1-20% of a benzotriazole-substituted silicone compound of the instant invention in combination with 0.1-20% of a 1,3,5-triazine derivative. See Abstract; col. 2, line 35 – col. 5, line 21; col. 7, line 35 – col. 8, line 26. The compositions of Allard et al. may additionally contain other hydrophilic or lipophilic organic sunscreens, inorganic sunscreens such as titanium dioxide, iron oxide, zinc oxide, etc., artificial tanning agents, cosmetically acceptable

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adjuvants such as fats, organic solvents, thickeners, etc. and may be formulated as emulsions, creams, gels, lotions, solid sticks and the like. See col. 8, lines 35-67; col. 9, lines 1-7, 34-39. The compositions of Allard et al. can be used in make-up products and in hair care products. See col. 9, lines 60-67; col. 10, lines 1-10. The compositions of Allard et al. are applied to human skin and/or hair and have SPF above 2. See col. 10, lines 24-35; col. 11, Table I.

Neither reference teaches Applicant's elected species of bis-resorcinyltriazine. However, the elected bis-resorcinyltriazine is known to be used in cosmetic compositions as UV-absorbers. See Huglin et al. at pp. 2-3, Examples 11 and 12.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use bis-resorcinyltriazine of Huglin et al. for cosmetic sunscreen compositions of either Hansenne or Allard et al. for its art-recognized purpose. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

9. No claim is allowed at this time.

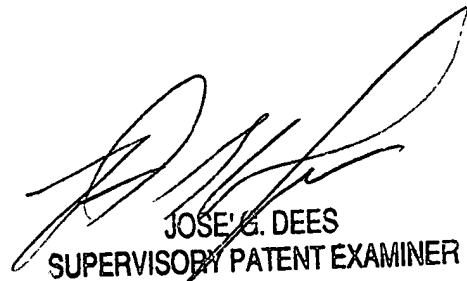
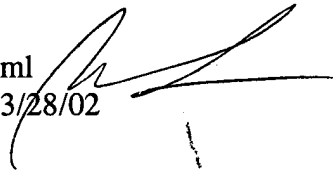
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml
3/28/02



JOSE G. DEES
SUPERVISORY PATENT EXAMINER
1616